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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/520,533	01/06/2005	Axel Jentzsch	263530US0PCT	9639
22850 7590 06/22/2007 OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER KASIREDDY, CHANDRAPRAKA	
			ART UNIT 1609	PAPER NUMBER
			NOTIFICATION DATE 06/22/2007	DELIVERY MODE ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/520,533

Applicant(s)

JENTZSCH ET AL.

Examiner

CHANDRAPRAKASH
KASIREDDY

Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/06/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1 to 17 are rejected on the grounds of non statutory-type double patenting as being unpatentable over claims 1 to 13 of US patent application No 10/515,636.

The instant claims are a suspension comprising at least one oxidative sensitive substance from the group consisting of carotenoids, retinoids and unsaturated fatty acids and solid particles of one or more salts of ascorbic

Art Unit: 1609

acid in a dispersant where said one or more salts of ascorbic acid is insoluble.

The instant claims directly fall within the scope of copending claims 1-9, 13.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are largely the same (antioxidants). Claim 1 is drawn a preparation comprising at least one retinoid, at least one water-soluble and oil soluble. Further one or more antioxidants is in the range from 0.05% to 0.8% by weight based on the total composition. Further claims 5 to 7, 13 revealed water-soluble antioxidants are L-ascorbic acid, salts of L-ascorbic acid and oil soluble antioxidant is α -tocopherol. The preparation as claimed in claim 1 in the form of a skincare preparation.

Whereas the instant claims are drawn to method of reducing oxidation of a human, a pharmaceutical, animal feed and cosmetic preparation, the use of salts of ascorbic acid, ascorbic acid and retinoids are well known in the art because all of these are related to antioxidants. One of ordinary skill in the art would have been motivated to modify the 10/514,636 method to a method for the preparation of cosmetic ointments, skin lotions, and pharmaceutical suspensions because the wide applications of the substances (Such as ascorbic acid, salts of ascorbic acid, retinoids and carotenoids).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not been patented yet.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 1 to 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Todd, Jr. et al. (US 5,230,836), in view of Kolter et al. (US 5,891,907) and The Merck index (12th edition, 1996, page 8723).

Todd Jr. et al. teaches (column 1, lines 10 to 16) oxidation of lipids and degradation of carotenoids is inhibited by solid particles of ascorbic acid, which are below 38 microns in size. The preparation and use of such solid ascorbic acid particles and of suspensions of such solid particles are disclosed. (column 1, lines 18-21). Solid ascorbic acid particles of less than 38 microns in size are shown to be effective antioxidants for substrates in which ascorbic acid is insoluble such as animal and vegetable oils, essential oils, carotenoids, and the

like. These particles are preferably prepared by wet milling ascorbic acid in a medium in which it is insoluble, until the size is less than 38 microns and preferably less. See column 3, lines 15 to 45. Todd et al. further teaches (in claims 13 and 33) the method of preparing an antioxidant composition, where ascorbic acid content is between about 5% and about 50% by weight in the medium.

Todd Jr. et al. revealed that the invention discloses for the first time that solid undissolved particles of ascorbic acid, less than 38 microns in size is an exceptionally powerful antioxidant media in which the particles are insoluble. (in specification column 5 lines 59 to 62). When formulated into a premix with carotenoids, the micron-sized ascorbic acid of the invention act both to stabilize the carotenoid and the fats in which they are dissolved are suspended when used in an animal feed. (column 6 lines 38 to 42).

Kolter et al. teaches (abstract) stable aqueous solubilizates which are suitable for parental administration of carotenoids and vitamins. A preferred antioxidant combination comprises B-carotene, tocopherol or tocopherol esters, and ascorbic acid for parental administration purposes. Kolter et al. further discloses the concentration of carotenoid; vitamin derivative is tocopherol, which further comprises ascorbic acid, See claims 1 and 7.

Merck teaches ascorbic acid and sodium ascorbate are useful antimicrobial and antioxidants in foodstuff.

In view of explicit teachings of Todd jr., Kolter et al. and Merck it would have been obvious to a person of ordinary skill in the art to further modify the composition of suspension by using salts of ascorbic acid as insoluble along with carotenoids, retenoids and unsaturated fatty acids for the administration to human foods, animal feeds, pharmaceuticals and cosmetic preparation with a reasonable expectation of success in preserving pharmaceutical, cosmetic and in human and animal nutrition. Thus the claimed invention is obvious over Todd Jr. et al. in view of Kolter et al. and The Merck index.

Conclusion

Claims 1- 17 are rejected.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Art Unit: 1609

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHANDRAPRAKASH KASIREDDY whose telephone number is (571) 272-1600. The examiner can normally be reached on 9.00 AM TO 5.00 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY STUCKER can be reached on (571) 272-0911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

CCPR.



JEFFREY STUCKER
SUPERVISORY PATENT EXAMINER